

REMARKS

Reconsideration of this application, in view of the foregoing amendment and the following remarks, is respectfully requested.

Claims 1-5 were originally presented for consideration in this application. Claims 6-14 were added by previous amendments. Claims 5 and 9 have previously been canceled without prejudice or disclaimer. Accordingly, claims 1-4, 6-8 and 10-14 are currently pending in this application.

The following rejections were set forth in the Office Action:

1. Claims 6-8 stand rejected under 35 USC §102(b) as being unpatentable over U.S. Patent No. 6,173,788 (Lembcke).
2. Claims 1-4, 10-12 and 14 stand rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,173,788 (Lembcke) in view of U.S. Patent No. 4,137,970 (Laflin).

Note that each of independent claims 1, 6 and 11 has been amended above to reverse most of the amendments made to these claims by an Amendment filed on October 9, 2009. The reversed amendments were unnecessary to overcome the claim rejections made in the July 16, 2009 Office Action.

Regarding the anticipation rejection of independent claim 6 based on the Lembcke reference, please note that this claim has been amended above. Claim 6 now requires that the packer include a material which swells and thereby increases in volume to seal off the annulus.

Lembcke does not describe such a packer. Instead, Lembcke describes a packer which is set by longitudinally compressing a seal element (see col. 2, lines 36-40). Therefore, Lembcke does not anticipate claim 6, and withdrawal of the rejections of this claim and its dependents is respectfully requested.

Regarding the obviousness rejections based on the Lembcke and Laflin references, please note that independent claims 1 and 11 each require that the packer includes a seal material which swells and thereby increases in volume. In contrast, Lembcke describes a packer which is set by longitudinally compressing a seal element (see col. 2, lines 36-40). Laflin does describe a swellable sealing member, but a person skilled in the art would not have found it obvious at the time the invention was made to have constructed the claimed invention based on the teachings of the Lembke and Laflin references.

The rejections do not satisfy the requirements set forth in the seminal U.S. Supreme Court case of *Graham v. John Deere* for evaluating whether an invention would have been obvious to a person of ordinary skill in the art at the time the invention was made. These requirements include determining the level of skill of the person having ordinary skill in the art, the scope and content of the prior art, and the differences between the claimed invention and the prior art. Additional considerations may include factors such as failure of others to solve the relevant problem, long felt but unsatisfied need, skepticism of others, teaching away in the prior art, unexpected results, copying, the pace of innovation in the art, commercial success, industry accolades, etc.

In the *Graham v. John Deere* opinion, the Supreme Court also explicitly warned against “slipping into use of hindsight” in obviousness determinations. *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966). Additionally, in the more recent case of *KSR v. Teleflex*, the Supreme Court has reiterated that an invention’s merit is not to be evaluated from a perspective of a person having the benefit of already knowing the solution conceived by the inventor, but rather as it would have been perceived by a

person having only ordinary skill in the pertinent art. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742-43 (2007).

In the present case, the person having ordinary skill in the art would likely have a bachelor's degree in engineering or a related applied science field, and would likely have several years' experience in designing packers for use in subterranean wells. Such a person would be aware of conventional compression-set packers and swellable packers.

The scope and content of the prior art have been discussed above. However, it should be noted here that neither of the Lembcke and Laflin references teaches or suggests positioning a cable duct in a swellable packer. Only the present applicant has discovered the problems inherent in positioning a cable duct in a mechanically-set packer (such as that described by Lembcke), and has applied swellable material technology to overcome these problems.

Other than the provision of a groove for accommodating an I-wire or control line, Lembcke describes a conventional mechanically-set packer, in which the sealing element is expanded radially outward by longitudinally compressing the element. Laflin teaches directly away from such conventional mechanically-set packers. Furthermore, Lembcke relies on the longitudinal compression of the sealing element to effect a seal around the I-wire or control line, and there is absolutely no teaching or suggestion whatsoever in the Laflin reference that such sealing of a groove around an I-wire or control line could be accomplished using a swellable seal element.

The Board of Patent Appeals and Interferences recently addressed this issue in *Ex Parte Whalen II* (Appeal 2007-4423, July 23, 2008) as follows:

The U.S. Supreme Court recently held that rigid and mandatory application of the "teaching-suggestion-motivation," or TSM, test is incompatible with its precedents. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). The Court did not, however, discard the TSM test completely; it noted that its precedents show that an invention "composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *Id.*

The Court held that the TSM test must be applied flexibly, and take into account a number of factors "in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed." *Id.*

at 1740-41. Despite this flexibility, however, the Court stated that “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements in the way the claimed new invention does.” *Id.* “To facilitate review, this analysis should be made explicit.” *Id.*

[W]hen the prior art teaches away from the claimed solution as presented here . . . obviousness cannot be proven merely by showing that a known composition could have been modified by routine experimentation or solely on the expectation of success; it must be shown that those of ordinary skill in the art would have had some apparent reason to modify the known composition in a way that would result in the claimed composition.

In the present case, no convincing reasoning has been presented as to why a person skilled in the art would have been motivated to make the invention recited in the claims. In the Office Action it is stated that, “the substitution of a known element for another to obtain predictable results is obvious to one of ordinary skill.” However, in the present case, there is much more than the substitution of one known element for another. Here we have the fact that the applicant has recognized a problem which no-one else recognized, produced a solution which no-one else has produced, and accomplished what no-one else has managed to accomplish.

Lembcke did not teach, suggest or motivate anyone to provide a cable duct in a swellable packer. Laflin did not teach, suggest or motivate anyone to provide a cable duct in a swellable packer. Instead, Lembcke taught that mechanically-set packers should be used when running I-wires or control lines through packers, and Laflin merely taught how to construct a swellable packer. There is absolutely no motivation to make the combination of these references as proposed in the Office Action. Accordingly, withdrawal of the rejections of claims 1, 11 and their dependents is respectfully requested.

In view of the foregoing amendment and remarks, all of the claims pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of claims 1-4, 6-8 and 10-14 is therefore earnestly solicited.

The examiner is hereby requested to telephone the undersigned attorney of record at (972) 516-0030 if such would expedite the prosecution of the application.

Respectfully submitted,

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I hereby certify that this correspondence is being filed in the U.S. Patent and Trademark Office electronically via EFS-Web, on November 9, 2009.

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